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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,752	03/15/2007	Hermann Neuhaus-Steinmetz	101769-365 KGB	7121
27384 7590 05/26/2009 NORRIS, MCLAUGHLIN & MARCUS, PA 875 THIRD AVENUE 18TH FLOOR NEW YORK, NY 10022				
EXAMINER NORDMEYER, PATRICIA L				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
05/26/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/583,752

Applicant(s)

NEUHAUS-STEINMETZ ET AL.

Examiner

Patricia L. Nordmeyer

Art Unit

1794

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF 298)
Paper No(s)/Mail Date 6/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1 – 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The claims use the terms “mechanically stressed state”, “mechanical stiffness” and “mechanically stressed state is frozen in that the film has resilience as a result of supply of energy”, and the specification fails to describe what is meant by the terms. How is a mechanically stresses state achieved? The specification discusses that the backing is in a stretched state but also discusses heating and cooling of the layers which causes the stress. Therefore, it is also confusing as to what the term mechanically stressed state is defined to be. How is mechanical stiffness different than mechanically stressed? What supplies the energy and how does it result in a film with resilience?

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 – 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “mechanically stressed state” in claims 1 and 3 is unclear, which renders the claim vague and indefinite. It is unclear from the specification and the claim language what the Applicant is considering to be a mechanically stressed state. The specification discusses that the backing is in a stretched state but also discusses heating and cooling of the layers which causes the stress. Therefore, it is also confusing as to what the term mechanically stressed state is defined to be.

The phrase “mechanically stressed state is frozen in that the film has resilience as a result of supply of energy” in claim 3 is unclear, which renders the claim vague and indefinite. What supplies the energy and how does it result in a film with resilience? How is the mechanically stressed state frozen?

Claims 4 – 8 are also rejected under 35 U.S.C. 112 2nd paragraph due to their dependency on the above rejected claims.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 – 8 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 02/34854 A1.

This rejection is over WO 02/34854 A1 because this reference qualifies as prior art under 35 U.S.C. 102(b). However, for convenience, the column and line numbers of the English language equivalent US Patent Application Publication 2004/0047985 A1 will be cited below.

WO 02/34854 A1 discloses an adhesive sheet comprising at least a backing and a layer of an adhesive, wherein the backing is in a mechanically stressed state (Page 1, Paragraphs 0012 and 0013) as in claim 1. With regard to claim 2, the adhesive sheet further comprises a release liner whose mechanical stiffness is greater than that of the backing material (Page 1, Paragraph 0012). For claim 3, the mechanically stressed state is frozen in that the film has a resilience as a result of supply of energy (Page 4, Paragraph 0071). Regarding claim 4, a shrink film is used as backing material (Page 1, Paragraph 0012; Page 4, Paragraph 0071). As in claim 5, the backing is coated on both sides with adhesive (Page 1, Paragraph 0012). With regard to claim 6, at least one adhesive has an elastic resilience (Page 1, Paragraph 0015). For claims 7 and 8, WO 02/34854 A1 also discloses process for producing punched products comprising punching the products from an adhesive sheet according to Claim 1 (Page 1, Paragraph 0001).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794